

REMARKS

Upon entry of the following amendments, claims 38-39 and 42-56 constitute the pending claims in the present application. Claims 1-37 and 40-41 are cancelled.

Amendments

As discussed in further detail below, in order to advance prosecution, Applicants have amended independent claims 38-39 and dependent claims 42-43 to recite the specific bicyclic ring system present in the cycloamine and jervine chemical skeletons. Applicants have also amended dependent claims 48 and 56 to correct antecedence.

Issues raised by the Office are addressed below in the order they appear and using the enumeration set forth in the outstanding Office Action. Applicants respectfully request reconsideration in view of the following remarks.

3-4. Claim Rejections – Provisional Nonstatutory Obviousness-Type Double Patenting over Application No. 11/338,503

The Office has provisionally rejected claims 38-39 and 42-58 (presumed claims 38-39 and 42-56) on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over claims 43, 50-53, 65, and 72-75 of co-pending Application No. 11/338,503. Without addressing the merits of this rejection, Applicants note that since this is a “provisional” rejection, upon a finding of the present claims as otherwise allowable, this “provisional” rejection must be withdrawn pursuant to the pendency of the 11/338,503 application (MPEP 804).

5. Claim Rejections – Provisional Nonstatutory Obviousness-Type Double Patenting over Application No. 11/270,984

The Office has provisionally rejected claims 38-39 and 42-56 on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over claims 27-42 of co-pending Application No. 11/270,984. Without addressing the merits of this rejection, Applicants note that since this is a “provisional” rejection, upon a finding of the present claims as otherwise allowable, this “provisional” rejection must be withdrawn pursuant to the pendency of the 11/270,984 application (MPEP 804).

6. Claim Rejections – Nonstatutory Obviousness-Type Double Patenting over US 7,098,196

The Office has rejected claims 38-39 and 42-56 on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over claims 7-15 of US 7,098,196. Without addressing the merits of this rejection, in order to expedite prosecution, Applicants are filing a terminal disclaimer herewith over US 7,098,196. Accordingly, Applicants request reconsideration and withdrawal of the rejection.

7. Amendment of the Claims to the Elected Invention

The Office contends that the claims are not limited to the “specific” bicyclic ring system in the elected group and are thus not limited to the chemical skeleton as defined by cyclopamine or jervine. In order to advance prosecution, Applicants have amended independent claims 38-39 and 42-43 to recite the specific bicyclic ring system present in the cyclopamine and jervine chemical skeletons, namely a spiro furo[3,2-b]piperidine ring system attached at the 2-position (the spiro feature is inherent in the corresponding formulas). Analogously, Applicants have also amended dependent claims 48 and 56 to correct antecedence. Applicants assert that the present claims are drawn to the elected invention, *i.e.*, the indicated methods comprising compounds possessing the chemical skeleton of cyclopamine and jervine. If the Office considers otherwise, Applicants request the Examiner’s cooperation in contacting the undersigned by telephone to resolve the issue so that the pendency of the present application is not unnecessarily extended.

8. Amending the Specification to Update the Status of Parent Applications

The Office has suggested that the cross-reference section of the specification be updated to include all parent applications and status thereof. Applicants respectfully point out that they have already complied with this request and note that in the Reply to Notice of Non-Responsive Amendment mailed April 14, 2006, the specification was amended to update the status of all parent applications. No further changes to the status of the parent applications have occurred in the interim.

CONCLUSION

In view of the above amendments, Applicants believe the pending application is in condition for allowance.

Reply dated March 13, 2007
In Reply to Office Action of November 13, 2006

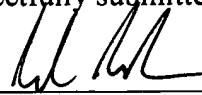
Application No. 09/708,964
Docket No.: JHUC-P04-010

Applicants believe no fee other than that required for the above-mentioned one-month extension of time is due with this response. However, if an additional fee is due, please charge our Deposit Account No. 18-1945, under Order No. JHUC-P04-010 from which the undersigned is authorized to draw.

Dated: March 13, 2007

Respectfully submitted,

By



Carl A. Morales, Ph.D.

Registration No.: 57,415
FISH & NEAVE IP GROUP
ROPES & GRAY LLP
One International Place
Boston, Massachusetts 02110-2624
(617) 951-7000
(617) 951-7050 (Fax)
Attorneys/Agents For Applicant